

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)	
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HENRY, Steven, G.)	Examiner: Ries, L.
)	
Serial No. 10/025,043)	Group Art Unit: 2176
)	
Filing Date: December 18, 2001)	Conf. No.: 6084
)	
For: METHOD AND APPARATUS FOR)	Atty. Dkt.: 10016441-1
ACCESSING NETWORK DATA)	
ASSOCIATED WITH A DOCUMENT)	

APPELLANT'S REPLY BRIEF

To: The Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer, paper number (unspecified), dated March 2, 2007.

RESPONSE TO EXAMINER'S ANSWER

In section 10 of the Examiner's Answer, the examiner responds to the arguments made by Appellant in the Appeal Brief. Appellant replies as follows.

Re the Anticipation Rejections:

The examiner fails to respond to the argument made by Appellant that the teachings of Mitchell are ambiguous as to the proper meaning of “other. . . HTML documents.” The examiner also fails to respond to the argument that, even if Mitchell’s teachings in this regard are unambiguous, Mitchell still cannot anticipate the pending claims because Mitchell is not enabling. The strengths of Appellant’s arguments are underscored by the fact that the examiner did not respond to them.

It is the position of Appellant that Mitchell fails to disclose a method wherein indicia on a document is used to access additional information *that is not part of the document itself*. That is, Appellant reads Mitchell’s “other. . . HTML documents” as referring only to other parts of the same document. On the other hand, the examiner reads “other. . . HTML documents” as extending to information that is not part of the document itself. Appellant’s construction of the term is based on a reading of the Mitchell reference in its entirety, taking into account the overall context of the Mitchell invention. Appellant’s position is fully briefed on pages 14-17 of the Appeal Brief.

The examiner’s position is based on but a single parenthetical comment in the Mitchell reference (lines 51-53 of column 7). The examiner’s reliance on that single parenthetical comment is in error because it is taken out of context. When read in context (as set forth pages 14 and 15 of Appellant’s Appeal Brief), it is far from clear whether Mitchell refers to other HTML pages of the *same document* (as understood by Appellant) or whether Mitchell intends to refer to other information that does not include the document itself (as argued by examiner). Significantly, the examiner does not assert that the Appellant’s reading of Mitchell is incorrect, nor does the examiner dispute the well-established precedent of the Board that an anticipation rejection cannot be predicated on an ambiguous reference. In short, the examiner has failed to

rebut Appellant's arguments.

However, even if Mitchell's teachings in this regard are viewed as unambiguous (which is denied), Mitchell still does not anticipate the pending claims because Mitchell is non-enabling as to whether his hyperlinks could be used to access information outside the document itself. Here again, the examiner does not address this point or explain how Mitchell is enabling in this regard. As pointed out by Appellant in the Appeal Brief (at pages 16 and 17), Mitchell contains no further description of the nature of such data that would be "other than the document itself" (in the language of the pending claims). The examiner also does not dispute the case law in this area which holds that for a reference to anticipate, it must be enabled and describe the invention sufficiently to have placed it in possession of a person having ordinary skill in the art.

Re the Obviousness Rejections:

The examiner also fails to address the substance of Appellant's arguments with regard to the non-obviousness of the pending claims. Instead, the examiner answers by simply re-asserting that it is enough that Block's word frequency calculations *could be* used in combination with the teachings of Mitchell. Of course, this re-assertion is not enough. Whether two references *could be* combined is not the test for obviousness.

As argued by Appellant on pages 20 and 21 of the Appeal Brief, there are two main problems with the examiner's obviousness rejections. The first problem is that neither Mitchell nor Block provides the suggestion or incentive required to combine them in the manner required by the pending claims. The second problem is that, even if Mitchell and Block were to be combined, the resulting combination would still fail to meet the limitations of the pending claims because of the deficiencies in Mitchell discussed above.

Appellant has argued that while Block discloses determining word frequency in a

document, Block does so for a different purpose: Namely to empirically correlate a word and a class. The examiner has not disputed this. However, the limitations in the pending claims require more than just determining word frequency. For example, claims 13 and 28 require “using the results of said frequency comparison to locate said network data.” Thus, there must be some teaching or suggestion in either Mitchell or Block that would provide the incentive to a person having ordinary skill to apply Block’s word frequency determination for an entirely different purpose. The examiner has failed to identify any such teaching or suggestion. Indeed, given the fact that Mitchell does not even disclose obtaining “network data” (i.e., data that do not include the document itself) in the first place, Mitchell cannot be said to provide the suggestion or incentive required to use a word frequency determination to obtain “network data.” Stated simply, Mitchell cannot be said to provide the suggestion or incentive required to aid in doing something that Mitchell does not even do. Block contains no such teachings, either, nor has the examiner ever pointed to teachings in Block that would provide the required suggestion or incentive.

Conclusion:

In summation, then, claims 1-7, 9-12, 14-22, 24-27, and 29-34 are not anticipated by Mitchell because Mitchell fails to disclose a method wherein indicia on a document is used to access additional information (i.e., information that is not part of the document itself). At best, the Mitchell reference is ambiguous and non-enabled in this regard, and an anticipation rejection cannot be predicated on an ambiguous or non-enabled reference.

Claims 8 and 23 are allowable because Mitchell’s hyperlinks are mere pointers to other places in the document itself; they do not comprise “network data” as required by the pending claims. Claims 13 and 28 are not obvious over Mitchell in view of Block because neither reference provides the suggestion or incentive required to combine them in the manner required

by the claims 13 and 28. Therefore, Appellant respectfully requests the Board to reverse the rejections of claims 1-34.

Respectfully submitted,

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